

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GUILLERMO RODOLFO CHACON

Appeal No. 2002-1429¹
Application No. 08/941,832

MAILED

JAN 29 2004

PAT & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF²

Before THOMAS, HAIRSTON, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

SECOND REMAND TO THE EXAMINER

We again remand this application to the examiner for action in consideration of the issues addressed below.

¹ This appeal is related to Appeal No. 2002-1624, Application No. 08/941,825.

² The oral hearing scheduled for April 10, 2003 was vacated in view of our earlier decision to remand the application.

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REASONS FOR SECOND REMAND

We remanded this application to the examiner pursuant to the provisions of 37 CFR § 1.196(a) and MPEP § 1211, which indicates in part that in the case of multiple rejections of a cumulative nature, the Board may remand the application for selection of the preferred or best grounds. We directed the examiner to select preferred or best grounds of rejection over the prior art for consideration on appeal.

We reproduce the following section from the earlier remand.

We further note that although the Answer refers to the disclosures of the references, none of the disclosures are directly applied to the requirements of the instant claims. The initial burden of presenting a prima facie case of unpatentability is on the examiner. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “[T]he Board must assure that the requisite findings are made, based on evidence of record.” In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

MPEP § 1208 sets forth the following pertinent requirements for an Examiner’s Answer, under “12.59 Grounds of Rejection”:

(iii) For each rejection under 35 U.S.C. 102, the Examiner’s Answer or single prior action, shall explain why the rejected claims are anticipated or not patentable under 35 U.S.C. 102, pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

....

(v) For each rejection under 35 U.S.C. 102 or 103 where there may be questions as to how limitations in the claims correspond to features in the prior art, the examiner, in addition to the requirements of (ii), (iii) and (iv) above, should compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side by side with a reference to the specific page, line

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number, drawing reference number and quotation from the prior art, as appropriate.

If any of the section 102 rejections are to be maintained, an Answer must point out where all the specific limitations recited in the rejected claims are found in the prior art relied upon. For each rejection over the prior art, the examiner should align the language of a representative claim side by side with reference to the specific page, line number, drawing reference number and quotation from the prior art, as appropriate.

The examiner has withdrawn all but two of the rejections over the prior art.

However, the statement of the rejection in the supplemental Answer mailed October 22, 2003 (Paper No. 34), at page 7, does not point out where ANY of the specific limitations in the rejected claims may be found in the prior art relied upon. The "Response to Argument" section of the supplemental Answer reproduces language of the instant claims, but does not correlate the particular claim limitations to the specific portions of each reference.

If either of the section 102 rejections are to be maintained, a supplemental Answer **MUST** point out where all the specific claim limitations are found in the prior art. To this end, **any supplemental Answer MUST align the language of a representative claim side by side with reference to the specific page, line number, drawing reference number and quotation from the reference relied upon, as appropriate.** Appellant may file a reply brief to a supplemental Examiner's Answer within two months from the date of such supplemental answer.³ 37 CFR § 1.193(b)(1).

³ We note a facsimile copy of a late reply (filed Jan. 13, 2004) in the file, in response to the supplemental Answer mailed Oct. 22, 2003.

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This application, by virtue of its "special" status, requires an immediate action.

See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

JAMES D. THOMAS
Administrative Patent Judge

KENNETH W. HAIRSTON
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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